

Interview Summary

Application No.

09/475,958

Applicant(s)

BITNER ET AL.

Examiner

Bradley L. Sisson

Art Unit

1655

All participants (applicant, applicant's representative, PTO personnel):

(1) Bradley L. Sisson.

(3) Rex M. Bitner.

(2) Karen King.

(4) Grady Frenchick.

Date of Interview: 13 July 2000.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☒ Yes e) ☐ No.

If Yes, brief description: *A proposed amendment to the claims was sent to the examiner via e-mail. A copy of which is attached hereto.*

Claim(s) discussed: 1, 8, and 21.

Identification of prior art discussed: *US Patents 3,652,761 (Weetall), 4,395,271 (Beall et al.), 5,075,430 (Little), 5,658,548 (Padhye et al.), and 5,523,231 (Reeve),*

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR § 1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Mr. Sisson acknowledged receipt of the information Disclosure Statement (IDS) of April 14, 2000 that applicant has resubmitted to the Office after learning that the original submission had been matched with the file and the art cited therein had not been considered on the merits. Mr. Sisson also acknowledged receipt of a supplemental IDS, and requisite Certification (37 CFR 1.97(e)), petition and petition fee, submitted on 12 July 2000.

Mr. Sisson directed attention to the patents of (1) Beall et al., as teaching the manufacture and use of magnetic particles comprising up to 70% SiO₂ (col. 6), for the immobilization of biological materials (col. 2). Beall et al., does not teach immobilizing cells or cellular materials. (2) Weetall discloses immobilizing proteins and nucleic acids to the surface of a silicate carrier that has available hydroxyl or oxide groups. Significantly, Weetall teaches the immobilization of proteins and nucleic acids to the silicate carrier through the use of an antibody that had been coupled to the carrier. Weetall does not teach immobilization of cells or nucleic acids to said carrier by direct coupling/adsorption. (3) Little, col. 3, teaches the immobilization to and elution of nucleic acids from diatomaceous earth. (4) Reeve discloses the use of "magnetizable material encapsulated in organic polymer," or magnetizable particles that do not have the organic layer (col. 2) in the immobilization of "biopolymers." Biopolymers are defined at column 3, fourth paragraph, as including "nucleic acids (DNA and RNA), proteins, polypeptides, polysaccharides, cell membrane material, bacteriophages, virus, and procaryotic and eucaryotic cells." It was noted that Reeve does not teach the use of a particle with the requisite surface. (5) Padhye et al., which is referenced at page 11, line 16, of the specification, teaches the use of glass particles that have at least 75% by weight SiO₂ (col. 4, ll. 40-41), that the glass particle is preferably used in combination with silica gel (col. 9, fifth para.) and that the glass bead/silica gel mixture is used in the isolation of DNA or RNA. Padhye et al., do not teach of using magnetic particles. While the specification of the subject application specifically teaches that the disclosed method is to encompass the use of such mixtures, the patent of Padhye et al., does not teach nor reasonably suggest the use of such particles in the immobilization of cells.

In response to concern raised by Mr. Sisson as to the claimed "pH dependent ion exchange particles" encompassing the use of a ligand such as an antibody so to immobilize cells, as the specification teaches the use of an amino acid coupled to the support (Example 8, pp. 26-28; Example 10, pp. 30-36), Dr. Bitner stated explicitly that "the ligand is not a polyamino acid chain." Mr. Sisson indicated that by having resolved such an issue, the claims are not considered to be either anticipated or rendered obvious by the teachings of Weetall.

Mr. Sisson indicated agreement to the proposed amendment to the claims. Ms. King authorized a Supplemental Examiner's Amendment.